

II. Examiner's Objections

Applicants thank the Examiner for withdrawing her objection to incorporating *Fonnum* into the specification by reference. Applicants also appreciate the withdrawal of the objections to claims 70-74, 77, 78, 80, and 81 under 37 C.F.R. § 1.75 as substantial duplicates of claims 1, 2, 75, and 76.

III. Rejection Under 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of claims 1-9, 11-21, 23-25, 30, 33, 50, 51, and 55-84 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,925,341 to Cervantes et al. ("the '341 reference") in combination with WO 99/36047 to Casperson et al. ("WO '047"). Despite the Examiner's comments in the outstanding Office Action, Applicants continue to traverse these rejections since she has not met the requisite burden for establishing a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met, including the showing of a suggestion or motivation to modify the reference or to combine reference teachings to obtain the claimed invention, and a reasonable expectation of success in making such a modification. The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See MPEP § 2143.

The Examiner alleges that "the motivation to combine references comes from the teaching of US '341 that the compositions can contain thickeners and the teaching of WO '047 that polyether-polyurethane polymers are thickeners." Office Action at 3. The Examiner does not demonstrate, however, how one skilled in the art would have been motivated to choose the polyether-polyurethane polymers in WO '047, particularly

because the polymers used in WO '047 were used in conjunction with an aqueous hair dye, whereas the environment in the present application is an oil-in-water emulsion.

The Examiner attempts to characterize the claimed invention as merely a combination of known elements. Even if the Examiner's assertion is accurate, it would not support a prima facie case of obviousness. Rather, as the Federal Circuit recognizes, virtually all inventions are combinations of old elements:

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

Yamanouchi Pharm. Co., Ltd. v. Danbury Pharmacal, Inc., 231 F.3d 1339 (Fed. Cir. 2000). Mere identification of the claimed components by the Examiner in these disparate teachings does not negate patentability of the claimed invention because nothing, other than the present disclosure, shows these components in combination, let alone in the claimed oil-in-water emulsion.

Significantly, WO '047 does not describe nanoemulsions as claimed, and therefore there cannot be any reasonable expectation of success for its combination with the '341 reference to achieve the claimed invention. One skilled in the art would know that adding the polymers of WO '047 to the oil-in-water nanoemulsion disclosed in the '341 reference would not necessarily result in a combination that is stable and remains a nanoemulsion. The Examiner does not remotely address this or the many deficiencies associated with this combination of references. Thus, the Examiner has

not pointed to evidence suggesting a reasonable expectation of success for the combination, as required by law.

Applicants respectfully disagree with the Examiner's attempt to rely on Kerkhoven as a short cut to establishing a prima facie case of obviousness without first establishing the elements of a prima facie case as required by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The rejection should be withdrawn for this reason alone.

Moreover, the Examiner's reliance on *Kerkhoven* to establish a *prima facie* case of obviousness is improper because neither the facts nor the holding of that decision apply to the present case. In *Kerkhoven*, the applicant claimed a process for preparing a detergent composition comprising mixing two known detergent materials. The court reasoned that "the idea of combining [the two detergent materials] flows logically from their each having been individually taught [each for the very same purpose, *i.e.*, as detergents] in the prior art." 205 U.S.P.Q. 1069, 1072. Based on this reasoning, the court held that the claims at issue requiring "no more than the mixing together" of two conventional detergents to make a third detergent composition set forth "prima facie obvious subject matter." 205 U.S.P.Q. 1069, 1072 (emphasis added).

The claimed invention, however, does not fall within the facts of *Kerkhoven* as it does not involve merely mixing two compositions, let alone the components individually taught in WO '047 and the '341 reference. The claimed invention teaches oil-in-water nanoemulsions comprising oil globules with an average size of less than 150 nm, comprising at least one oil and at least one amphiphilic lipid that can be thickened with

at least one nonionic polymer. In other words, the claimed invention is not directed to mixing two components, both of which have the very same purpose, to produce a third composition, which also has the same purpose. Rather, the claimed invention is directed to the improved and unexpected properties associated with components that have difference purposes.

In contrast to *Kerkhoven*, and in an effort to reproduce Applicants' claimed invention, the Examiner is picking and choosing individual components (as opposed to compositions) from isolated disclosures in the cited references. However, "[s]uch piecemeal reconstruction of the prior art patents in light of [Applicant's] disclosure is contrary to the requirements of 35 U.S.C. 103." *In re Wesslan*, 147 USPQ 391, 393 (CCPA 1965).

That the Examiner's improper reconstruction of prior art to obtain the claimed invention does not form a proper basis for establishing obviousness has been further supported by the Federal Circuit, which recently emphasized that the Patent Office must not only "assure that the requisite findings are made, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). In the present case, the Examiner is relying on conclusory statements when dealing with particular teachings of prior art references and specific claims, without properly setting forth the rationale on which she relies to support the assertion of obviousness. Specifically, she has not explained why one skilled in the art would have been motivated to combine the cited references as they not only teach different uses (oxidative hair dyes vs. cosmetic

or dermato-pharmaceutical applications), but components contained in fundamentally different environments (e.g., aqueous vs. oil-in-water emulsions.) For at least these reasons, there is no reasonable expectation of successfully obtaining the claimed invention from the combination of references relied on by the Examiner. At best, the combination of references would have made the claimed invention obvious to try. It is well known, however, that "obvious to try" cannot support a rejection under 35 U.S.C. §103. *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988).

The Examiner must point to "clear and particular" evidence showing a motivation to combine the teachings of the multiple references (*In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)) and that based on the combination of references, there would have been a reasonable expectation of successfully obtaining the claimed invention. In view of the foregoing, it is clear that the Examiner has not met the required burden, as she has not shown that either of these requirements have been met. Accordingly, Applicants respectfully request withdrawal of the rejection.

IV. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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